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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,766	06/02/2006	Michael H. Bracey	TSRI 923.1	8883
2387 7590 06/29/2009 Olson & Cepuritis, LTD. 20 NORTH WACKER DRIVE 36TH FLOOR CHICAGO, IL 60606			EXAMINER STEADMAN, DAVID J	
			ART UNIT 1656	PAPER NUMBER
			MAIL DATE 06/29/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/534,766

**Applicant(s)**

BRACEY ET AL.

**Examiner**

David J. Steadman

**Art Unit**

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/CDC)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

- [1] Claim 1 is pending in the application.
- [2] Applicant's amendment to claims, filed on 4/15/09, is acknowledged. This listing of the claims replaces all prior versions and listings of the claims.
- [3] Applicant's amendment to the specification, filed on 4/15/09, is acknowledged.
- [4] Applicant's remarks filed on 4/15/09 in response to the Office action mailed on 10/15/08 have been fully considered and are deemed to be persuasive to overcome at least one of the rejections and/or objections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Rejections and/or objections to claim 2 are withdrawn in view of the cancellation of the claim.
- [5] The text of those sections of Title 35 U.S. Code not included in the instant action can be found in a prior Office action.

### ***Specification/Informalities***

- [6] The specification is objected to in identifying the sequence at Figure 4 as being amino acids 404-433 of SEQ ID NO:1 (instant specification amendment to p. 5, paragraph 20) because the Figure 4 sequence has undefined amino acids, while amino acids 404-433 of SEQ ID NO:1 does not. In other words, the sequence of amino acids 404-433 of SEQ ID NO:1 is not identical to the amino acid sequence set forth in Figure 4. Moreover, it is noted that the specification identifies position 429 of SEQ ID NO:1, *i.e.*, leucine, as a hydrophilic residue. However, leucine is known in the art as being a

hydrophobic residue, not a hydrophilic residue. Appropriate correction is required. It is suggested that applicant identify the amino acid sequence shown in Figure 4 with a separate sequence identifier and modify the description of Figure 4 accordingly.

***Claim Rejections - 35 USC § 112, First Paragraph***

[7] The written description and scope of enablement rejections of claim 1 under 35 U.S.C. 112, first paragraph, are withdrawn in view of the instant amendment to claim 1 to limit the sequence of the polypeptide, the ligand and the characteristics of the crystal.

***Claim Rejections - 35 USC § 102***

[8] The rejection of claim 1 under 35 U.S.C. 102(a) as being anticipated by Hanson is maintained for the reasons of record and the reasons set forth below. The rejection was fully explained in a prior Office action. See paragraph 15 beginning at p. 19 of the Office action mailed on 10/15/08.

RESPONSE TO ARGUMENT: Beginning at p. 6 of the instant remarks, applicant argues the Hanson reference is applicant's own work and was published less than 1 year before the effective filing date of the instant application and thus is not "by another".

Applicant's argument is not found persuasive. While applicant argues the Hanson reference is "the inventors' own work", there is no indication in the reference of Hanson that this is the work of an entity other than inventor Michael A. Hanson. According to MPEP 2132.III, "The term 'others' in 35 U.S.C. 102(a) refers to any entity which is

different from the inventive entity. The entity need only differ by one person to be "by others." The reference of Hanson has a single author, Michael A. Hanson, while the instant application names four inventors in the Declaration under 37 CFR 1.63, filed on 6/2/06. Thus, the "entity" of the Hanson reference is different from the "inventive entity" of the instant application. As such, the reference of Hanson is "by another" and the reference of Hanson is properly available as prior art under 35 U.S.C. 102(a).

### ***Claim Rejections - 35 USC § 103***

[9] The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Santarsiero in view of Cravatt is withdrawn in view of the instant amendment to claim 1 to limit the sequence of the polypeptide, the ligand, and the characteristics of the claimed crystal.

[10] The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Patricelli in view of Amersham is withdrawn in view of the instant amendment to claim 1, particularly to limit the characteristics of the crystal.

### ***Conclusion***

[11] Status of the claims:

- Claim 1 is pending.
- Claim 1 is rejected.
- No claim is in condition for allowance.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Fri, 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Steadman/  
Primary Examiner, Art Unit 1656